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10/613,479

07/03/2003

Chun Yuen To

NTD 206-KFM

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07/20/2006

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EXAMINER

GATES, ERIC ANDREW

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/613,479

Applicant(s)

TO, CHUN YUEN

Examiner

Eric A. Gates

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3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to Applicant's amendment filed on 17 April 2006.

#### ***Drawings***

2. The replacement drawings were received on 17 April 2006. These drawings are acceptable.

#### ***Response to Amendment***

3. The amendment filed 17 April 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the phrase "each of the rings comprising a pair of half ring elements of circular cross-section" on page 5 of the marked up specification, lines 7-8, and the phrase " Each of the rings comprises a pair of half ring elements of circular cross-section" in the abstract. The "circular cross-section" portion of these phrases adds new matter to the specification because this information was not included in the original disclosure or drawings. The original disclosure identified the ring elements as being formed from cylindrical rods. The *Oxford English Dictionary*, online version, states that a cylinder is "In *mod. Geom.*, the solid generated by a straight line moving always parallel to itself and describing any fixed curve (not necessarily a circle)." While older definitions may define a cylinder as

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having two circular ends, it is well understood in modern mathematics that a cylinder is not required to have circular ends unless it is identified as a "circular cylinder".

The phrase "a right-side up "U" on page 14 of the marked up specification also adds new matter to the disclosure because it was not included in the original disclosure or drawings.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6 and 10-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "half ring elements of circular cross-section" in lines 13-14 of claim 1 adds new matter to the claim because the limitation "circular cross-section" was not included in the original disclosure, as described in paragraph 3 above.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1-4, 6, and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kissel (U.S. Patent 4,690,580).

8. Regarding claim 1, Kissel discloses a ring binder mechanism for binding the sheets of loose leaves, the mechanism comprising: an elongated spring plate 1 that extends longitudinally, and, in profile, has a shallow U-shaped configuration and opposite edges which extend substantially toward each other (see figure 6); two parallel elongate hinge plates 11/12 (parallel along their length) supported by said spring plate for pivotal toggle motion relative to the spring plate about a central hinge line (see column 2, lines 63-64), the hinge plates being mounted in parallel and retained by the opposite edges of the spring plate; a plurality of rings 2/3 for claspingsaid sheets of loose leaves, each of the rings comprising a pair 2 and 3 of half ring elements of circular cross section (the cross section of the bore 6 of free end 6 of ring 2 is circular, and the cross section of free end 7 is circular) mounted on said hinge plates, with one half ring element of each pair being attached to one of the hinge plates and the other half ring element of the pair attached to the other hinge plate, with the two half ring elements of each pair in substantial alignment, the pairs of half ring elements being movable with said hinge plates to toggle between an open position and a closed position and forming

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a substantially annular shape when in the closed position (Webster's Online Dictionary definition of annular is "of or relating to a ring", elements 2 and 3 are identified as "ring portion", see column 2, line 17); wherein free ends 6/7 of the half ring of each pair of elements form a nesting configuration when in the closed position, the free end of one half ring element of each pair having a centrally concave nesting portion 6 and the free end of the other half ring element of the pair having a centrally convex nesting portion 7, said concave portion 6 and said convex portion 7 being symmetrical about an axis line of the respective ring elements of the pair, so that when the pair of half ring elements are in the closed condition, the free ends of the half ring elements are aligned to each other and form a surface-engagement so that the convex nesting portion 7 and concave nesting portion 6 are nested together tightly.

9. Regarding claim 2, Kissel discloses wherein said concave nesting portion has a conical hole 9 that is formed in the free end of one half ring element, a diameter of the hole being smaller than that of the respective half ring element.

10. Regarding claim 3, Kissel discloses wherein the convex nesting portion 7 has a substantially conical protruding portion 8 with an outer diameter of a base of the protruding portion 8 being smaller than the diameter of the respective half ring element 3.

11. Regarding claim 4, Kissel discloses wherein the opening of said concave nesting portion 6 in the free end of one half ring element of each respective pair has a substantially conical hole 9 that is formed from its external end surface and an internal cylindrical hole 6 that is connected to said conical hole.

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12. Regarding claim 6, Kissel discloses wherein the protruding portion 7 of said convex nesting portion 7 has a cylindrical shape 7, and the opening of said concave nesting portion 6 has a shape of an internal cylindrical hole 6.
13. Regarding claim 10, Kissel discloses a ring binder mechanism according to claim 1, wherein two rings 2/3 are provided in said ring binder mechanism.
14. Regarding claim 11, Kissel discloses a ring binder mechanism according to claim 1, wherein said rings 2/3 are made of metal material (see page 1, line 24).
15. Regarding claim 12, Kissel discloses a ring binder mechanism according to claim 1, wherein said rings 2/3 are made of plastic material (see page 1, lines 35-38).
16. Regarding claim 13, Kissel discloses a ring binder mechanism according to claim 1, wherein said rings 2/3 are formed integrally with said hinge plates 11/12 (see Figure 6).

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kissel in view of To et al. (U.S. Patent Publication 2003/0044221 A1).
19. Regarding claim 5, Kissel discloses a ring binder mechanism according to claim 4, the opening of said concave nesting portion 6 has a conical hole 9 that is formed from

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its external end surface and an internal cylindrical hole 6 that is connected to said conical hole 9. Kissel does not disclose that the protruding portion of said convex nesting portion has a shape that "consists of" a cylindrical tip and an arc-shaped annular conical base portion.

To et al. teaches the use of a protruding portion 52 of a half ring element 48 that has a shape consisting of a cylindrical tip and an arc-shaped annular conical base portion (see Figure 2 and paragraph 26) for the purpose of providing suitable alignment and mating engagement with the corresponding recess on ring 50 (see page 2, paragraph 26 of To et al.). Therefore, and particularly absent any alleged criticality for the convex nesting portion having a shape that "consists of a cylindrical tip and an arc-shaped annular conical base portion" (noting for example at least figures 10, 11, 12, and 13 of the instant application), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binder mechanism of Kissel with the protruding portion of To et al. in order to have a binder with nesting portions that fit and align better.

### ***Response to Arguments***

20. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Examiner will address any arguments to the extent that they were not rendered moot by the new rejections above.

21. In response to applicant's argument that the "patent to Kissel discloses the use of rings which are oval in cross-section and form a rectangular configuration when in the



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closed position" and therefore fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., rings which have an outer circular cross section and are formed in a circular ring) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that the hole in Kissel meets the claimed "circular" cross-section claim language, and that the "rectangular" configuration still forms an "annular" ring (as described in detail in the rejection above based on Kissel).

22. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding the argument that To et al. "discloses a completely different type of binder mechanism than that of the present invention, with no spring element or hinge plates", To et al. wasn't relied upon to teach any specific claimed structure of the "spring element" or "hinge plates".

23. In response to applicant's argument that To et al. is nonanalogous art ("To et al. disclose a completely different type of binder mechanism than that of the present invention"), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

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(Fed. Cir. 1992). In this case, the invention of To et al relates to the instant application in that it is also a ring binding mechanism and as such is in the field of applicant's endeavor.

24. For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG  
9 July 2006



ERICA CADOGAN  
PRIMARY EXAMINER

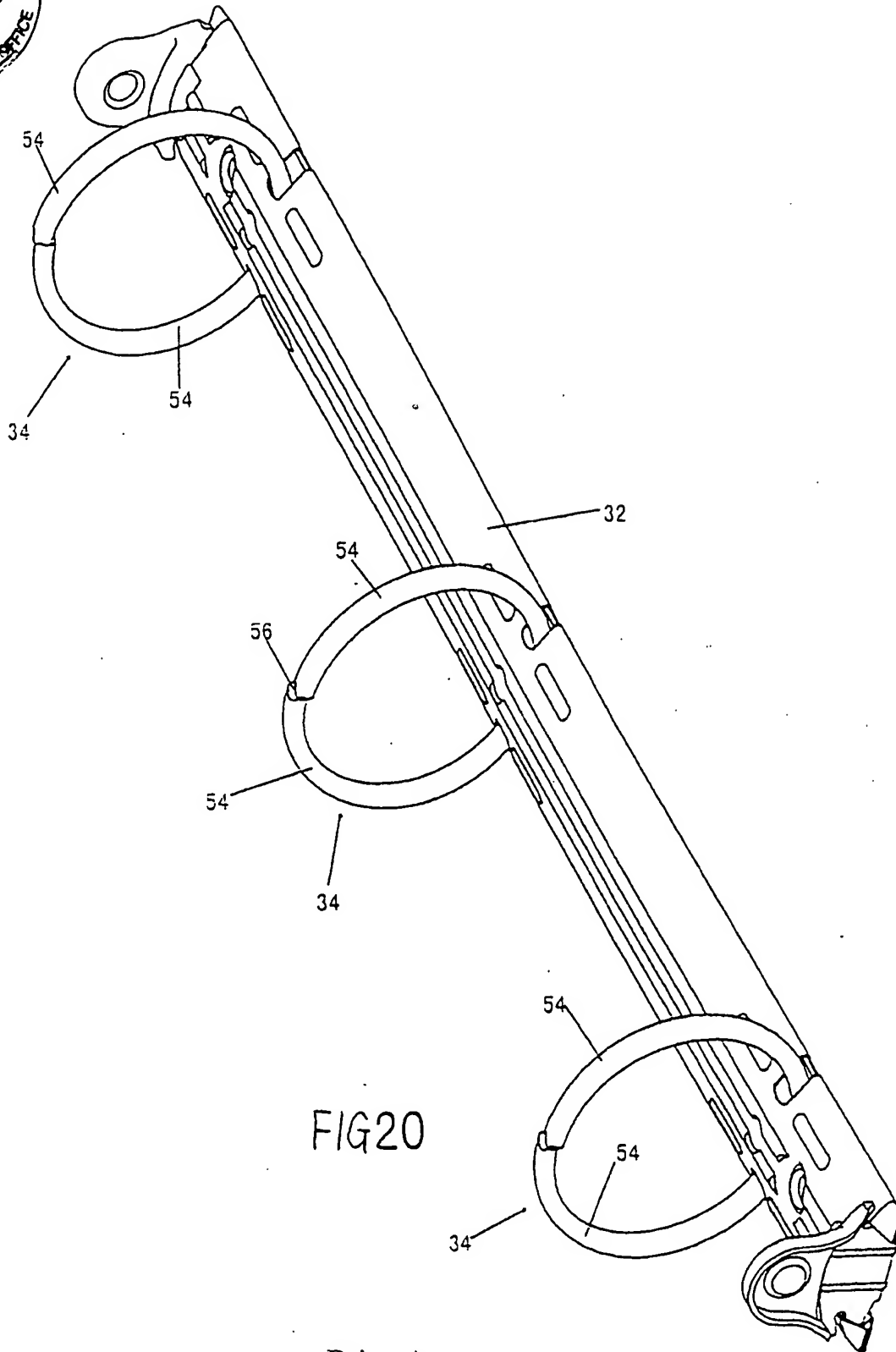
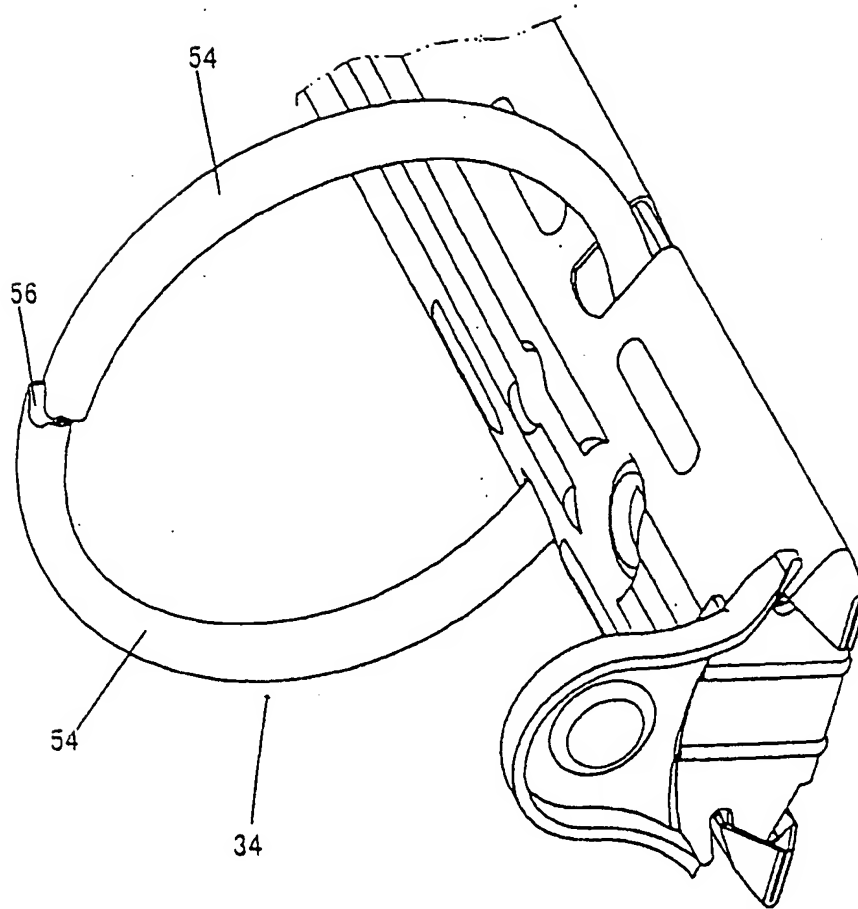


FIG 20

Prior Art

Approved  
LAD 7/4/06



Prior Art

FIG 21

Approved  
Laz 7/9/06